REMARKS

Favorable reconsideration and allowance of the subject application are respectfully requested. Claims 1-10 are pending in the present application, with claims 1, 6, and 9 being independent.

Priority

Applicant respectfully requests that the Examiner acknowledge Applicant's claim for priority (see item 12 of the Office Action Summary).

Claim Rejections Under 35 USC §112

The Examiner rejected claims 1-5 under 35 USC §112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

Applicant has amended claim 1 in an effort to clarify the claim. Accordingly, withdrawal of the rejection is respectfully requested.

Claim Rejections Under 35 USC §103

The Examiner rejected claims 1-10 under 35 USC §103(a) as being unpatentable over *Doenges* (US 4,987,584) in view of *Usami* et al. (US 5,422,739). This rejection is respectfully traversed insofar as it applies to the presently pending claims.

Doenges is directed to an X-ray imaging system that identifies

organic materials and produces a material information signal and a luminance signal on the basis of detected radiation. The material information signal is utilized to control a color of an image of an article that is displayed on a monitor and the luminance signal is utilized to control image brightness, color saturation, and white content of the displayed article.

Usami et al. is directed to a color image reading system that converts inputted color image signals into color data signals. These color data signals represent vertices of a triangle that circumscribe a spectral locus of a CIE color degree diagram. The system of *Usami* et al. then outputs the inputted color image signals to an image output device in response to the provisions of the color data signal.

In rejecting independent claims 1, 6, and 9, the Examiner alleges that the combination of *Doenges* and *Usami* et al. teaches the features of the independent claims. Applicants, however, respectfully submit that the Examiner failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion of motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art

reference must teach or suggest all the claim limitations, see *In re Vaeck*, 947 F.2d 48, 20 USPQ2d 1438 (Fed.Cir.1991).

The Examiner acknowledges on page 4 of the Office Action that *Doenges* does not teach the features (generalized here by Applicants) that the adjustment of the brightness level takes into consideration the sensitivity of the human eye or that the brightness level of a sub-object is adjusted if that sub-object has a substantially equal absorption attribute to an absorption attribute of another sub-object. The Examiner, however, cites *Usami* et al. for support thereof. Specifically, the Examiner alleges that col. 5, lines 5-35 of *Usami* et al. teaches that "due to the nature of color characteristics, for example, the color green is perceived to be much brighter by the human eye than the color blue" and that "a matrix operation...is performed to correct the brightness level of the colors when they are displayed," see page 4 of the outstanding Office Action. This statement made by the Examiner is incorrect.

Referring to col. 5, lines 5-35, of *Usami* et al. it is merely taught that a matrix operation is performed to convert image data and that a shading circuit 8 corrects variations in sensitivities of a color solid-state image pickup element array 5 and variations in the illuminance of the original illumination unit 3. Further, to correct the spectral sensitivities, the R, G, and B signals from a color sensor are processed. Thereafter, the blue region in the red

spectral sensitivity and the red region in the blue spectral sensitivity are eliminated, see column 4, lines 40-48. *Usami* et al., however, contains absolutely no teaching with respect to the human perception of colors on the basis of brightness. Basically, *Usami* et al. is merely teaches that the color gamut of an input image is converted so that it can be provided to an output apparatus.

Furthermore, the cited references do not contain any motivation to combine. An essential evidentiary component of an obviousness rejection is a teaching or suggestion or motivation to combine the prior art references.[1] Combining prior art references without evidence of a suggestion, teaching or motivation simply takes the inventors' disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight.[2] Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or in some cases, from the nature of the problem solved.[3] However, a rejection cannot be predicated on the mere identification of individual components of the claimed limitations.[4] Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed

[1] see *C.R. Bard, Inc. v. M3 Systems, Inc.*, 48 USPQ2d 1225 (Fed. Cir. 1998).
[2] see *Interconnect Planning Corp. v. Feil*, 227 USPQ 543 (Fed. Cir. 1985).
[3] see *In re Dembiczak*, 50 SPQ2d 1614 (Fed. Cir. 1999).
[4] see *In re Kotzab*, 55 USPQ2d 1313 (Fed. Cir. 2000).

invention would have selected these components for combination in the manner claimed.[5]

Applicant respectfully submits that the Examiner has used nothing more than hindsight in order to combine *Doenges* and *Usami* et al., and has identified nothing in either publication that could be construed as a suggestion, teaching or motivation to combine the prior art references. Thus, the Examiner's reference combination is improper and should be withdrawn for the following reasons.

The Examiner incorrectly alleges on pages 4-5 of the Office Action that "by adapting Usami's matrix operation technique as shown in figure 5, the colors of articles in Doenges [that are] displayed on an output means, such [as] a color monitor, will have equal brightness levels to human eyes." *Doenges*, however, contains absolutely no teaching such that one skilled in the art would look towards *Usami* et al. in order to make up for the deficiencies of *Doenges*.

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned."[6] Furthermore, MPEP 2141.01(a) states that PTO classification is some evidence of "nonanalogy" or "analogy". See, for example, *Wang*

[5] Id.
[6] see *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Laboratories, Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993) (Patent claims were directed to single in-line memory modules (SIMMs) for installation on a printed circuit motherboard for use in personal computers. Reference to a SIMM for an industrial controller was not necessarily in the same field of endeavor as the claimed subject matter merely because it related to memories. Reference was found to be in a different field of endeavor because it involved memory circuits in which modules of varying sizes may be added or replaced, whereas the claimed invention involved compact modular memories).

Doenges et al. has a U.S. and International classification of 378/100 and H05G 1/64, respectively. *Usami* et al. has U.S. and International classification of 358/518 and HO4N 1/46, respectively.

Further, referring to page 2, second paragraph, of the specification, it is taught that if two materials having identical absorption and are made from different materials, the two materials appear to have different brightness levels to the human eye because of the human eye's sensitivity to different colors and this results in a conclusion that, for example, a blue object is subjected to a higher absorption than a green object because a green object is perceived to be much brighter than a blue object. Thus, an unpleasant visual strain is placed on the operator of the X-ray imaging system and also it is difficult to discern objects that are

represented by darker colors, in particular, if the displayed images are superimposed.

Therefore, because *Usami* et al. is not in the field of appellant's endeavor nor is it reasonably pertinent to the particular problem with which the inventor was concerned, one skilled in the art would not look towards *Usami* et al. to make up for the deficiencies of *Doenges*.

Furthermore, neither *Doenges* nor Usami et al. contain any teaching that the brightness levels of a sub-object are adjusted on the basis of a comparison of an absorption attribute of one sub-object to another sub-object's absorption attribute.

As such, because there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings, the Examiner failed to discharge his burden in establishing a *prima facie* case of obviousness.

Dependent claims 2-5, 6-7, and 10 are dependent claims, which should be considered allowable at least for depending from an allowable base claim.

Accordingly, withdrawal of the rejection is respectfully requested.

Conclusion

In view of the above amendments and remarks, this application appears to be in condition for allowance and the Examiner is, therefore, requested to reexamine the application and pass the claims to issue.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Martin Geissler (Reg. 51,011) at telephone number (703) 205-8000, which is located in the Washington, DC area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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